

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAND A. SOUTH
and
J. MICHAEL SPALL

Appeal No. 97-0744
Application No. 08/270,851¹

ON BRIEF

Before COHEN, NASE, and CRAWFORD, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 7, 9 to 17 and 19 to 23, which are all of the claims pending in this application.

¹ Application for patent filed July 5, 1994.

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We REVERSE.

BACKGROUND

The appellants' invention relates to a mount for a camera-PC terminal. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the examiner's answer.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Guddee	5,052,651	Oct. 1,
1991		
Tani	5,318,257	June
7, 1994		

Claims 1 to 7, 9 to 17 and 19 to 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Guddee in view of Tani.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 14, mailed September 30, 1996) for the examiner's complete reasoning in support of the rejection, and to the appellants'

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brief (Paper No. 13, filed August 5, 1996) for the appellants'
arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the appealed claims. Accordingly, we will not sustain the examiner's rejection of claims 1 to 7, 9 to 17 and 19 to 23 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). The conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual

to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we turn to the examiner's rejection of the claims on appeal. The examiner found (answer, p. 3) that

Guddee shows the basic structure of the claimed terminal support device including base 22, 24, 30, 32 defining a plane adapted to be removably attached to a supporting surface, first side member 14, 16, 17, second side member 80, 81, and top portion 82 coupled to and extending orthogonally from the second side member.

The examiner thereafter determined (answer, p. 4) that

[i]t would have been obvious to modify Guddee's device by mounting Tani's shaft member to Guddee's second side

member in order to provide camera mounting means as taught by Tani.

The appellants argue (brief, pp. 10-11) that the examiner has not established prima facie obviousness of the claimed subject matter since the examiner has not provided any explanation (i.e., motivation) as to why an artisan would have mounted Tani's shaft member to Guddee's second side member. We agree. Tani discloses a pedestal 4 mounted to a planar display table (i.e., base) 3a. A camera supporting mechanism 5 is mounted to Tani's pedestal 4. Tani teaches that the camera supporting mechanism 5 includes a tubular body 7, a movable arm 8 and a camera holder 9. It is our opinion that the combined teaching of Guddee and Tani would have at best suggested to one of ordinary skill in the art at the time the invention was made the mounting of Tani's pedestal and camera supporting mechanism to Guddee's base, not Guddee's second side member as set forth by the examiner. Thus, it appears to us that the examiner has resorted to speculation and/or improper hindsight reconstruction to reject the claims under appeal. Accordingly, the decision of the examiner to reject

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claims 1 to 7, 9 to 17 and 19 to 23 under 35 U.S.C. § 103 is
reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 7, 9 to 17 and 19 to 23 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

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APPLICATION NO. 08/270,851

APJ NASE

APJ CRAWFORD

APJ COHEN

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 14 Aug 98

FINAL TYPED: